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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/848,231
Filing Date: May 04, 2001
Appellant(s): APPELMAN, BARRY

Barry Appelman
For Appellant

CORRECTED EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/6/06 appealing from the Office
action mailed 11/03/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-------------|-------|--------|
| 20020021307 | Glenn | 2-2002 |
| 5,948,058 | Kudoh | 9-2000 |

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| | | |
|-----------|-----------|---------|
| 6,081,830 | Schindler | 6-2000 |
| 6,525,747 | Bezos | 2-2003 |
| 6,446,112 | Bunney | 9-2002 |
| 6,640,230 | Alexander | 10-2003 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4, 6 – 9, and 11 – 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 further in view of Schindler (US 6,081,830)

As per claim 1, Glenn et al. (“Glenn”) teaches a communications method for transferring electronic data between users of a communications system, the method comprising: upon opening of the electronic message by the recipient, indicating an online

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state of one or more of the sender and any other recipient of the electronic message (see Glenn, paragraphs 0021 and 0022).

Glenn does not teach delivering an e-mail from a sender to at least one recipient and the electronic message as an e-mail message.

Kudoh et al. (“Kudoh”) teaches delivering an e-mail message from a sender to at least one recipient and the electronic message as an e-mail message (see Kudoh, column 4, lines 32 – 36). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Kudoh with the method of Glenn in order to allow messages to be read hours or days after they are sent.

Glen and Kudoh teach the method of claim 1. (see rejection above). Glenn and Kudoh do not teach the method indicating other recipient of the electronic message.

Schindler further teaches a method indicating the online state of the sender and every other recipient of the chat room. (See Schindler, column 7, lines 45-55)

It would have been obvious to an artisan at the time of the invention to include Schindler’s teaching with method of Glenn and Kudoh in order to allow user to see the states of the other users.

As per claim 2, which is dependent on claim 1, Glenn, Kudoh, and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 further comprising sending a message to at least one of the sender and any other recipient based on the online state (see Glenn, paragraph 0046).

As per claim 3, which is dependent on claim 2, Glenn, Kudoh and Schindler teach the method of claim 2 (see rejection above). Glenn further teaches the method of claim 2 wherein the message comprises an instant message (see Glenn, paragraph 0046).

As per claim 4, which is dependent on claim 2, Glenn, Kudoh and Schindler teach the method of claim 2 (see rejection above). Glenn further teaches the method of claim 2 wherein the message comprises an e-mail message (see Glenn, paragraph 0046).

As per claim 6, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 wherein indicating the online state comprises displaying a graphical user interface to the recipient (see Glenn, figure 3, items 206 and 209 and paragraph 0022).

As per claim 7, which is dependent on claim 6, Glenn, Kudoh and Schindler teach the method of claim 6 (see rejection above). Glenn further teaches the method of claim 6 wherein the graphical user interface comprises an icon positioned next to an e-mail address in the e-mail message (see Glenn, figure 3, items 206 and 209)

As per claim 8, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above), Glenn further teaches wherein indicating the online state comprises indicating whether the sender is online, offline, or not a member of the communications system (see Glenn, paragraph 0022).

As per claim 9, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 1 wherein indicating the online state comprises accepting a request to check user online state (see Glenn, paragraph 0045, lines 10 –15; it is inherent that the query to check user online state is accepted because a result is returned).

As per claim 11, which is dependent on claim 9, Glenn, Kudoh and Schindler teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 9 wherein the request comprises an Internet protocol (see Glenn, paragraph 0025; the examiner interprets the AOL instant messaging protocol as an internet protocol),

As per claim 12, which is dependent on claim 11, Glenn, Kudoh and Schindler teach the method of claim 11 (see rejection above). Glenn discloses the method of claim 11 wherein the Internet protocol is hypertext transfer protocol (see Glenn, paragraph 0011).

As per claim 13, which is dependent on claim 9, Glenn, Kudoh and Schindler teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 9 wherein the request is initiated by a client of the user (see Glenn, paragraph 0045, lines 10 – 15).

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As per claim 14, which is dependent on claim 9, Glenn, Kudoh and Schindler teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 9 further comprising sending a redirection command based on the online state (see Glenn, paragraph 0046; the examiner interprets sending the message via electronic mail instead of as an instantaneous message when the user is offline as sending a redirection command based on the online state).

As per claim 15, which is dependent on claim 9, Glenn, Kudoh and Schindler teach the method of claim 9 (see rejection above). Glenn further teaches the method of claim 14 wherein the redirection command comprises a uniform resource locator (see Glenn, paragraph 0056, lines 17 – 24).

As per claim 16, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches wherein, indicating the online state comprises establishing a persistent connection to an instant messaging server (see Glenn, paragraph 0068).

As per claim 17, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches wherein indicating the online state comprises checking a control port (see Glenn, paragraph 0127).

As per claim 18, it is of similar scope to claim 1 and is rejected under the same rationale as claim 1 (see rejection above).

As per claim 19, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a disc (see Glenn, paragraph 0150, lines 5 – 8).

As per claim 20, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a client device (see Glenn, paragraph 0017).

As per claim 21, which is dependent on claim 18, Glenn, Kudoh and Schindler Kudoh teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a host device (see Glenn, paragraph 0153, lines 3 – 6).

As per claim 22, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the computer program of claim 18 wherein the computer readable medium comprises a propagated signal (see Glenn, paragraph 0152).

As per claim 23, it is of similar scope to claim 1 and is, rejected under the same rationale as claim 1 (see rejection above).

As per claim 24, it is of similar scope to claim 20 and is rejected under the same rationale as claim 20 (see rejection above).

As per claim 25, it is of similar scope to claim 21 and is rejected under the same rationale as claim 21 (see rejection above).

As per claim 26, it is of similar scope to claim 1 and is rejected under the same rationale as claim 1 (see rejection above).

As per claim 27, it is of similar scope to claim 6 and is rejected under the same rationale as claim 6 (see rejection above).

As per claim 28, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 1 (see rejection above). Glenn further teaches the method of claim 27 wherein a graphical user interface enabled for a first online state differs from a graphical user interface enabled for a second online state (see Glenn, paragraph 0022).

As per claim 29, it is of similar scope to claim 6 and is rejected under the same rationale as claim 6 (see rejection above).

As per claim 30, it is of similar scope to claim 28 and is rejected under the same rationale as claim 28 (see rejection above).

As per claim 31, which is dependent on claim 1, it is of the same scope as claim 8.
(See rejection above)

As per claim 32, which is dependent on claim 1, it is of the same scope as claim 2.
(See rejection above)

As per claim 33, which is dependent on claim 1, it is of the same scope as claim 2.
(See rejection above)

As per claim 34, which is dependent on claim 1, Glen, Kudoh and Schindler teach the method of claim 1. (see rejection above). Schindler further teaches a method indicating the online state of the sender and every other recipient of the chat room. (See Schindler, column 7, lines 45-55)

As per claim 35, which is dependent on claim 1, it is of the same scope as claim 8.
(See rejection above)

As per claim 36, which is dependent on claim 1, Glenn, Kudoh and Schindler teach the method of claim 1, Glenn further teaches where indicating online state comprises providing one or more indicator to the recipient. (Figure 2, item 206)

As per claim 37, which is dependent on claim 36, it is of the same scope as claim 34. (See rejection above)

As per claim 38, which is dependent on claim 36, it is of the same scope as claim 34. (See rejection above)

As per claim 39, which is dependent on claim 36, Glenn, Kudoh and Schindler teach the method of claim 36, Glenn further teaches comprising selecting at least one of the visual indicators to initiate at least one user interface. (Figure 2, item 206)

As per claim 40, which is dependent on claim 39, Glenn, Kudoh and Schindler teach the method of claim 39, Kudoh further teaches wherein selecting the at least one visual indicator initiates at least one user interface configured to enable the recipient to send an email message communication to an identity associated with visual indicator. (see Kudoh, column 4, lines 32 – 36)

As per claim 41, which is dependent on claim 39, Glenn, Kudoh and Schindler teach the method of claim 39, Glenn further teaches wherein selecting the at least one visual indicator initiates at least one user interface configured to enable the recipient to send an instant message communication to an identity associated with the visual indicator. (See Glenn, paragraph 0046)

As per claim 42, which is dependent on claim 18, Glenn, Kudoh and Schindler teach the method of claim 18, Glenn further teaches wherein the instruction for indicating the online state comprise instruction for indicating the online state of the sender of the e-mail message. (See Glenn, paragraph 0046)

As per claims 43-45 are rejected with the same rationale as claim 34. (See rejection above)

As per claim 46, which is dependent on claim 18, it is of the same scope as claim 39. (See rejection above)

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As per claim 47, which is dependent on claim 23, it is of the same scope as claim 42. (See rejection above)

As per claims 48-50 are rejected with the same rationale as claim 34. (See rejection above)

As per claim 51, which is dependent on claim 23, it is of the same scope as claim 8. (See rejection above)

As per claim 52, which is dependent on claim 26, it is of the same scope as claim 42. (See rejection above)

As per claims 53-55 are rejected with the same rationale as claim 34. (See rejection above)

As per claim 56, which is dependent on claim 26, it is of the same scope as claim 8. (See rejection above)

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 as applied to claim 4 above, further in view of Schindler (US 6,081,830) and further in view of Bezos, U.S. Patent No. 6,525,747.

As per claim 5, which is dependent on claim 4, Glenn, Kudoh and Schindler teach the method of claim 4 (see rejection above). They do not teach the method of claim 4 wherein the e-mail message comprises an invitation to join the communications system. Bezos teaches wherein an e-mail message comprises an invitation to join the

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communications system (see Bezos, column 7, lines 5 – 31). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Bezos with the method of Glenn, Kudoh and Schindler in order to allow the user to provide other users with access to private discussion information.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glenn et al., U.S. Patent Application Publication No. US 200210021307 in view of Kudoh et al., U.S. Patent No. 5,948,058 as applied to claim 9 above, further in view of Schindler (US 6,081,830), and further in view of Bunney, U.S. Patent No. 6,446,112.

As per claim 10, which is dependent on claim 9, Glenn, Kudoh, Schindler teach the method of claim 9 (see rejection above). They do not teach the method of claim 9 wherein the request comprises at least one e-mail address. Bunney et al. (“Bunney”) teaches wherein a request to check user online state comprises at least one e-mail address (see Bunney, column 10, lines 1 – 9). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Bunney with the method of Glenn, Kudoh, and Schindler in order to allow a user to link existing email addresses with internet chat handles.

(10) Response to Argument

Applicant alleges that Glenn and Kudoh fail to teach upon opening of the e-mail message by the recipient indicating an online state of one or more of the

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sender and any other recipient of the email message because Glenn fails to teach upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message.

Examiner disagrees. The limitation only requires indication of the online state of either the sender or one other recipient and Glenn teaches the former.

Glenn teaches displaying online state of the sender. In Glenn, users on the network can indicate their online presence to the presence engine with the command interface, which includes a presence indicator switch. (see Glenn; paragraph 0054) So if the users want to indicate they are online, (see Glenn; figure 3, item 206) they would turn on the switch, (see Glenn; figure 3, item 200) and if they want to show they are not online, (see Glenn; figure 2, item 206) they would turn off the switch. (see Glenn; figure2, item 200, paragraph 0055) Furthermore, users can specify when and how they wish to receive reply message data to the presence engine. (see Glenn; paragraph 0055) The presence Engine then embeds all these information and a presence indicator into electronic documents that can be "sent across a interconnection fabric and displayed by a client program." (see Glenn; paragraph 0056, figure 3, item 204) Although Glenn keeps referring to these users as "receiving users", it does not negate the fact these "receiving users" provide the information about their online statues, provide information about how they can be reached, and alternately provide the information about an ad regarding an autographed baseball jersey. (see Glenn; figure 2, items 204) Therefore, one of these "receiving users" is the

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sender and the creator of this autographed baseball jersey ad, and any one, who is interested, would find out whether the seller is online upon opening the ad. (see Glenn; figure 2, item 204) Because Glenn teaches the limitation of upon opening of the electronic message by the recipient, indicating an online state of one or more of the sender and any other recipient of the electronic message (see Glenn; paragraph 0054-0056 figure 2, item 204) and Kudoh teaches delivering information in an email form, (see Kudoh; column 4, lines 32-40) therefore the combination of the references teaches upon opening of the e-mail message by the recipient indicating an online state of one or more of the sender and any other recipient of the email message.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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